

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Stephen P.A. FODOR, *et al.* Confirmation No.: 9541

Serial No.: 09/724,928

Group Art Unit: 1631

Filed: November 28, 2000

Examiner: K. R. Skowronek

For: METHODS FOR ANALYZING POLYMER ARRAYS

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**RESPONSE TO COMMUNICATION UNDER 37 CFR § 1.105**

In response to the Communication under 37 C.F.R. § 1.105 dated August 3, 2007,  
Applicants submit herewith an Information Disclosure Statement and the following comments to  
satisfy the requirements of the Examiner.

## REMARKS

The Communication under 37 C.F.R. § 1.105 dated August 3, 2007 requires that Applicants identify all references cited in the Information Disclosure Statement filed June 5, 2007 which disclose (a) a method of forming an array of preformed nucleic acids or immobilizing preformed nucleic acids on a substrate or (b) an array, substrate or solid support comprising nucleic acids at a density of more than 400 different nucleic acids/cm<sup>2</sup>. In a teleconference between the Examiner and Michael Tuscan, agent for the Assignee of the present invention, it was agreed that references which disclose “a method of forming an array of preformed nucleic acids or immobilizing preformed nucleic acids” may not be germane to the subject matter claimed in the present application. Accordingly, this paper is limited to documents which, upon information and/or belief, appear to arguably disclose an array, substrate or solid support comprising different, nucleic acids at a density of more than 400 different nucleic acids/cm<sup>2</sup>.<sup>1</sup>

With the exception of Documents 13-15, 20, 27, 30-32, 34, 45, 50, 54-55, 57, 63, 65-66, 68-71 and 73-90, all Documents provided on the attached 1449 form have been previously submitted to the Examiner in an Information Disclosure Statement and have not been considered by the Examiner. Accordingly, copies of these Documents are not being provided.

In addition to the previously cited references, Applicants have identified additional references which appear to disclose subject matter agreed upon by the Examiner. Documents 13-15, 20, 27, 30-32, 34, 45, 50, 54-55, 57, 63, 65-66, 68-71 and 73 appear to arguably disclose an array of nucleic acids at a density of 400 or more nucleic acids/cm<sup>2</sup>. Copies of Documents 34, 45, 50, 54-55, 57, 63, 65-66, 68-71 and 73 as well as Documents 80-90 (discussed below) are provided herein. All Documents which have not previously been submitted to the Examiner in an Information Disclosure Statement are listed in the Information Disclosure Statement filed herewith so that the Examiner may consider the additional references.

Applicants note that several of the cited references on the included 1449 form relate to third party proceedings. See, for instance, Documents 34-43, 46-48, 54-55, 58-59, 64-67 and 70-

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<sup>1</sup> The statements made here reflect Applicants' initial review of these documents. Applicants reserve the right to challenge the disclosure or interpretation of the disclosure of any one or more references.

72, which were specifically prepared for third party proceedings. In order to assist the Examiner and expedite prosecution, a brief description of several of these papers is provided below. Applicants do not believe that the subject matter of any of the third party proceedings outlined below or disclosed in the Information Disclosure Statement filed June 5, 2007 is closely related to the subject matter claimed in the present application.

Document 34 is a brief that was filed during litigation between Affymetrix (assignee of present application) and Synteni, Inc. and Incyte Pharmaceuticals, Inc. The litigation involved U.S. Patent Number 5,800,992, the claims of which were subsequently invalidated. The claims of the '992 patent were generally directed to a method of detecting nucleic acid sequences on an array. Document 34, filed by Affymetrix, is a brief in support of a motion for a preliminary injunction. Document 59, titled "Joint Claim Construction Statement," provides a table that corresponds to the limitations of the claims of the '992 patent. Pages 8-11, 14-15, 19 and 26 of this paper disclose density limitations.

Documents 35 and 37-40 are papers related to Interference 104,358, which also involved U.S. patent 5,800,992. Document 39 is a transcript of the deposition of Larry Kricka. Page 66 of the transcript discloses that Kricka did not think that the Gait reference taught the density limitation of 400 nucleic acids/cm<sup>2</sup>. Document 40 is a transcript of the deposition of Sir Walter Bodmer. Page 80 of the transcript provides a discussion regarding the density requirement of more than 400 nucleic acids/cm<sup>2</sup>. Documents 35 and 37 summarize the outcome of proceedings related to U.S. patent 5,800,992.

Documents 36, 42, 47 and 66-67 are papers from the Opposition Proceeding of European Patent EP 0972564 (revoked). European Patent EP 0972564 contained claims directed to an array of preformed polymers at a density of 1000 or more nucleic acids/cm<sup>2</sup>.

Applicants also would like to bring to the Examiner's attention a request for *ex parte* reexamination of U.S. Patent Number 5,445,934 which was filed June 25, 2007 and assigned control number 90/008675. The request for reexamination is discussed in more detail in the Information Disclosure Statement Pleading included herewith. The references cited in the request for reexamination are provided in the attached 1449 form as Documents 74-90.

Applicants respectfully request that the Examiner consider the references cited in the enclosed 1449 form and invite the Examiner to contact the undersigned should there be any new or remaining questions.

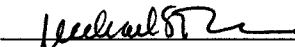
Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-1283. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Dated: October 3, 2007

Respectfully submitted,  
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